Remarks

Claim amendments

Claims 22, 30, 39 and 42 have been amended. Support for this amendment is found in the specification at page 7, first paragraph.

Rejection of Claims under 35 U.S.C. § 102

Claims 22-25, 29-30, 36-38 and 42 have been rejected under 35 U.S.C. § 102 as being anticipated by U.S. Patent No. 6,466,966 B1 ("Kirsch").

The Applicants respectfully traverse the rejection of claims 22-25, 29-30, 36-38 and 42. The law pertaining to a rejection of a claim under §102 was recited in the earlier RCE. In short, "[a]nticipation requires that all of the elements and limitations of the claims are found within a single prior art reference." (*Scripps Clinic and Research Found. v Genetech. Inc.,* 927 F.2d 1565, 1576, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991 (emphasis added)). There must be no difference between the claimed invention and the reference disclosure. (*Scripps Clinic and Research Found. v. Genetech, Inc.,* id. (emphasis added)).

In the following arguments, the Applicants will focus in particular on independent claims 22, 30, and 42, as the Applicants believe those claims to be allowable over Kirsch. It is axiomatic that any claim which depends from an allowable base claim is also allowable, and therefore the Applicants do not believe it is necessary to present arguments in favor of each and every rejected dependent claim.

The Applicants again respectfully contend that the Examiner has mischaracterized Kirsch. In the previous response, the Applicants argued that in Kirsch's method, the web page displayed to the user (web page 92, Fig. 5) is not the web page generated by the "web tool" accessed by the web user ("web page server 82, Fig. 5). In response the Examiner notes at Col. 7, lines 10-17 that Kirsch states,

"Thus, **a web page** served by an HTTPd server system ... **embeds a URL reference** to a web page served by the logically external server system. **Selection of this embedded URL through the client browser** of the client computer system 12 results initially in an HTTP transaction with the server system 16 rather than the external server." (Emphasis added by Examiner.) The Examiner then argues that the "selection of [the] embedded URL" *inherently* requires that the web page be displayed to the user. However, this is not the case. In fact, the "selection" of the embedded URL is performed **automatically** by the browser, as is clear from Col. 13 lines 24-28 of Kirsch, which state, "Specifically, *the embedded information controls the operation of the Web browser* on the client computer system sufficient to issue a notification URL 98 directed to the redirection target server system 88, as shown in FIG. 5. **The server process 100 initiated in response to the notification URL receipt produces the redirection message** that is returned to the client computer system 80." (Emphasis added.) Accordingly, the web page 84 (Fig. 5) which <u>includes the user information</u> is **not** inherently displayed to the user, since the "selection" recited in Col. 7 lines 10-17 is performed by the **web browser**, and <u>not</u> by the user. This position is further supported by Figs. 6 and 7 of Kirsch, which only show a <u>single</u> banner click which then causes the process depicted in Fig. 5 to be performed. That is, if the "selection" referred to in Col. 7 lines 10-17 were performed by the <u>user</u>, then the processes depicted in Figs. 6 and 7 of Kirsch would show a <u>second</u> banner click, which they do <u>not</u>.

Notwithstanding, the Applicants have amended claims 22, 30, and 42 to recite (in slightly varying language) that "the web page files ... include[ ] user information associated with the web user's use of the web tool ... [and] wherein **the web page files correspond to desired information to be received and viewed by the user.**" (Emphasis added.) That is, it is now clear from claims 22, 30 and 42 that <u>the web page files that *include the user information* are **also** the web page files that the user</u>

desires to receive and view. Support for this amendment is found in the specification at page 7 first paragraph, which states in part: "Within the session, the user transmits to a web tool server requests for receiving and viewing **desired information**. Upon receiving a request, the web tool server through its executing web tool 113 generates and transmits to the user's browser a responsive **web page file containing the desired information**." (Emphasis added.)

Accordingly, *even* **if it is true that Kirsch displays to the user the web page that includes the user information (i.e., web page 84 of Fig. 5), then it is clear that this web page (84) is not the web page that "correspond[s] to desired information to be received and viewed by the user"**. That is, the web page in Kirsch that corresponds to "desired information to be received and viewed by the user" is web page 92 (Fig. 5), which does not contain any user information – it is only web page 84 that contains the user information. As stated in Kirsch's own words, "Indeed, as evident to the user of the client computer 80, *the only response recognized as significant is the receipt 116 of the Web page 92.*" (Kirsch, Col. 13, lines 61-64; emphasis added.) That is, the content desired by the user is web page 92, not web page 84. Put another way, web page 84 includes the user information that is to be tracked, but it does not include the page content desired by, and to be displayed to, the user.

The Applicants respectfully request that the Examiner review the annotated copy of Kirsh's Fig. 5 that was provided with the last response, and the accompany description at Col. 12 of Kirsch. It will be evident from Fig. 5, and the accompanying description, that Kirsch's method is substantially different than the Applicants' claimed method. Further, it should be noted that the description at Col. 7 of Kirsch that the Examiner relies on accompanies Fig. 1 of Kirsch, and as can be seen, Fig. 1 is merely a figure showing equipment components of a generic Internet-based client/server system – there are no data flow or data processing steps shown.

Accordingly, Fig. 1, and the accompanying description at Col. 7, are not specific, and cannot be considered as actually describing any process disclosed by Kirsch.

For at least these reasons, the Applicants contend that claims 22, 30, and 42, and those claims which depend therefrom, are now patentable over Kirsch, since they contain a limitation not found in Kirsch (i.e., the limitation that the web page that is transmitted to the user, and which includes the user information, is _also_ the web page that contains the information desired to be viewed by the user). Accordingly, the Applicants request that the rejection of claims 22-25, 29-30, 36-38 and 42 as being anticipated by Kirsch be removed and that the claims be allowed.

Rejection of Claims under 35 U.S.C. § 103(a)

Claims 26-27, 31-35, 39 and 41 have been rejected under 35 U.S.C. § 103 as being obvious over U.S. Patent No. 6,466,966 B1 ("Kirsch") in view of U.S. Published Application US 2003/0220998 A1 to Jennings III et al. ("Jennings").

The Applicants contend that claims 26-27, 31-35, 39 and 41 are not obvious over Kirsch in view of Jennings.

The requirements to maintain a 103 rejection have been set forth in the previous response. In brief, MPEP 706.02(j) states, "[t]o establish a _prima facie_ case of obviousness, ... the prior art reference (or references when combined) **must teach or suggest all the claim limitations.**" (Emphasis added.)

In the previous response the Applicants argued that neither Kirsch nor Jennings taught or suggested the use of a "BIT" tag that, when executed by the user computer, causes user information to be sent to a designated server. In that response, the Applicants explained what the term "BIT tag" means ("BIT" being an acronym for "Broken Image Tracking"), where support for the expression "BIT tag" is found in the specification, and why the references do not show the use of a BIT tag, as that term is used by the Applicants in their claims. In response, the Examiner

appears to take the position that the Applicants have argued limitations not found in the claims. The Examiner states that, "Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims."

The Applicants respectfully contend that they have not argued limitations not found in the claims, but have merely presented arguments as to why the cited references do not show the claimed features. It is well known that a patent draftsperson is entitled to be his or her own lexicographer, and to define terms, so long as those terms are not repugnant to the common usage of the language. Here, the Applicants have defined in the specification the term "BIT tag", and have then used that term in the claims. Specifically, the first paragraph of page 4 of the specification recites:

The present invention provides and employs the use of Broken Image Tracking ("BIT") for tracking user information for users of a web site or web tool. With BIT, the web page generating program (e.g., a web tool program) inserts a "broken image" tag in various (or even all) of the web pages transmitted to a user. In general, a BIT tag is a HTML image tag (or equivalent) with a BIT URL, i.e., a URL that includes embedded user information and a broken image file designator. As used herein, a broken image file is a file that cannot be located, e.g., because it does not exist or because its directory path does not point to it. The BIT URL has a file path that directs the user's image-retrieving browser to an information gathering ("broken image") web server. With the designated broken image file in the URL, the broken image server will attempt but will not be able to find and retrieve to the browser the broken image file. This causes the server to log (in its error log) the BIT URL, which includes the user information. In this way, user information can be

collected and routed into a centralized repository such as the error log within the broken image server.

Since the term "BIT tag" is thus well defined in the specification by the Applicants, the use of that term in the claims is entirely acceptable, and inherently includes the full scope of the term as defined in the specification. The Applicants should not be required to insert into the claims the complete definition of a term that is provided in the specification. To require otherwise would be contrary to the long held tenant that a patent draftsperson is entitled to be his or her own lexicographer. Furthermore, the use of the term "BIT tag" is not repugnant to any ordinary use of the term.

The Applicants note that the Examiner has not argued that Kirsch and Jennings show the use of a "BIT tag", as that term is defined by the Applicants in the specification, but only that the Applicants have apparently argued limitations not set forth in the claims. However, since the term "BIT tag" is well defined in the specification, and the references do not show an equivalent component, the Applicants contend that the rejected claims are, in fact, allowable over Kirsch in view of Jennings.

For at least this reason, the Applicants contend that claims 26-27, 31-35, 39 and 41 are not obvious over Kirsch in view of Jennings. The Applicants therefore request that the rejection of these claims be removed and the claims allowed.

Further, with respect to independent claim 39, and claims 40 and 41 which depend therefrom, claim 39 has been included to include the limitation that "the web page files [which include the user information] correspond to desired information to be received and viewed by the user". This amendment is essentially the same amendment as was made to claims 22, 30 and 42, and was discussed above. Accordingly, claim 39 (and inherently, claims 40 and 41 which depend therefrom)

now include a limitation neither taught nor suggested by the prior art, and should therefore be allowed.

For at least all of reasons stated above, the Applicants contend that none of rejected claims 22-27, 29-39, 41, and 42 (as respectively amended) are anticipated by Kirsch, or are obvious over Kirsch in view of Jennings. The Applicants therefore respectfully request timely allowance of claims 22-42.
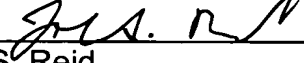
Summary

The Applicants believe that this response constitutes a full and complete response to the Office action, and therefore request timely allowance of all claims 22 through 42.

The Examiner is respectfully requested to contact the below-signed representative if the Examiner believes this will facilitate prosecution toward allowance of the claims.

Respectfully submitted,

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